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NXP, B.V. NXP INTELLECTUAL PROPERTY & LICENSING M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			ZAMAN, FAISAL M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHIAS MUTH

Appeal 2009-002172
Application 10/534,164
Technology Center 2100

Decided: May 28, 2010

Before JOHN A. JEFFERY, JAMES D. THOMAS, and LEE E. BARRETT,
Administrative Patent Judges.

BARRETT, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant filed a Request for Rehearing of our decision entered January 12, 2010. Appellant requests that we modify our decision to state that: (1) the Examiner was reversed; (2) the decision constitutes a new ground of rejection of claim 1 under 37 C.F.R. § 41.50(b); and (3) the rejection of dependent claims 2-6 was not addressed.

The Request for Rehearing is granted.

ANALYSIS

Upon reconsideration, we conclude that our original decision departed from the rejection stated by the Examiner substantially enough that it would be unfair not to state that the Examiner's rejection of claims 1-6 is reversed and not to denominate our decision a new ground of rejection as to claim 1. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) (the "ultimate criterion" of whether a rejection is new is "whether appellants have had fair opportunity to react to the thrust of the rejection.").

The Examiner rejected independent claim 1 and dependent claim 6 under 35 U.S.C. § 103(a) based on Feuerstraeter, Appellant's admitted prior art (AAPA) at Spec. 1, lines 7-17, and Ishikuri. Our decision concluded that the Examiner erred in finding that: (1) the AAPA does not describe a system base chip; (2) Ishikuri teaches a system voltage supply; and (3) a transceiver performs a monitoring function. Op. 10. We found that the AAPA taught these limitations (Op. 10), however, in doing so, we relied upon a portion of the AAPA at Spec. 2, lines 11-14 not relied upon by the Examiner.

Although Appellant is charged with knowledge of his own Specification, since the Examiner's rejection was not based on the specific teaching of the AAPA that we relied upon, we agree that the Examiner's stated rejection of claims 1-6 should be reversed and our decision should be denominated a new ground of rejection of claim 1.

As to the rejection of dependent claims 2-6, we did not address these claims because their patentability was not separately argued (*see* Br. 8). However, since we denominate our decision a new ground of rejection as to claim 1, we acknowledge that the patentability of dependent claims 2-6 has

Appeal 2009-002172
Application 10/534,164

not been addressed. We leave it to the Examiner to consider the patentability of dependent claims 2-6.

CONCLUSION

The Request for Rehearing is granted. Accordingly, our original decision is modified to hold: (1) the Examiner's rejections of claims 1-6 under 35 U.S.C. § 103(a) are reversed; and (2) a new ground of rejection is entered as to only claim 1.

GRANTED

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